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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

ROLEX WATCH U.S.A., INC.,

Opposer

vs.

AFP IMAGING CORPORATION

Applicant.

Opposition No.: 91188993

Serial No.: 77/492,131

BRIEF OF OPPOSER

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BRIEF OF OPPOSER

I. STATEMENT OF THE CASE

Opposer, Rolex Watch U.S.A., Inc. (hereafter “Opposer” or “Rolex”), filed a Notice of Opposition against Applicant, AFP Imaging Corp.’s (hereafter “Applicant”) mark ROLL-X which is the subject of Application Serial No. 77492131 in International Class 10 for goods described as “x-ray tables for medical and dental use.” Applicant filed an intent to use application on June 2, 2008.

As grounds for the Opposition, Opposer asserts that its ROLEX trademark, registered since 1915, is famous and widely recognized and associated with high quality watches in the United States and throughout the world. As such, Applicant’s use of a substantially similar mark, ROLL-X, is likely to cause dilution, impairing the distinctiveness and harming the reputation of the ROLEX trademark, in violation of Section 43(c) of the Trademark Act (15 USC § 1125 (c)).

As a second and independent ground for Opposition, Opposer asserts that Applicant lacked a bona fide intent to use the mark ROLL-X when Applicant filed its application for registration in violation of 15 USC § 1051(b).

Applicant, in its Answer, has denied the allegations relating to Opposer's claims of dilution and no bona fide intent at the time of filing its application.

II. RECORD BEFORE THE COURT

The record before the Board consists of: the pleadings; the file of Applicant's ROLL-X application; Opposer's two Notices of Reliance; Opposer's testimony in the form of the Declarations of Peter Nicholson and Philip Johnson;¹ and, Applicant's Notice of Reliance.

A. Opposer's Testimony and Evidence

1. Opposer's Notices of Reliance

Opposer relies on the USPTO's TARR electronic database records showing that U.S. Registration No. 101, 819 for the mark ROLEX issued January 12, 1915 is currently valid and subsisting and owned by Opposer.

Opposer also relies on Applicant's responses to Opposer's interrogatories 2, 3 & 4 which all identify David Vozick, Applicant's President and CEO, as being most knowledgeable about the selection, plans and information relevant to Applicant's seeking and filing an application for registration for the mark ROLL-X.

¹ The Testimony, by Declarations of Nicholson and Johnson, is pursuant to stipulation of the parties.

Finally, Opposer relies on selected portions of the discovery deposition of David J. Vozick taken by Opposer on March 3, 2010(hereafter “Vozick Dep.”). The excerpted portions confirm that Mr. Vozick is the founder and Chief Executive Officer of Applicant, AFP Imaging, Corp. (Vozick Dep. p. 8, lines 17-21). Mr. Vozick testified that the x-ray tables sold by AFP Imaging, Corp. are mostly for veterinary use. (Vozick Dep. p. 19, line 13 – p. 21, line 4). Mr. Vozick states that “[o]f the x-ray table portion, I would say 80-90 percent is veterinary.”(Vozick Dep. p. 20, lines 5-6) Specifically, the product to be sold under the proposed ROLL-X mark is “intended for veterinary use”. (Vozick Dep. p. 27, lines 6-19). These portions of Mr. Vozick’s testimony are relevant because they support Opposer’s selection of the universe of respondents surveyed in its dilution survey conducted by Philip Johnson, discussed herein.

In addition, during Mr. Vozick’s deposition, Opposer introduced Vozick Exhibit 4, Responses to a Second Request for Production of Documents, in which Applicant responded that no documents exist, other than the application filed, to support its statement that it had the requisite bona fide intent to use the applied for mark for the recited goods at the time of filing. Mr. Vozick’s testimony confirms this statement. (Vozick Dep. p.34.)

Mr. Vozick also testified that no business or marketing plans exist showing how the ROLL-X mark may be used. (Vozick Dep. p. 34.) Nor has there been test marketing or a projected date of first use. (Vozick Dep. pp. 34,35) While Mr. Vozick stated that one movable x-ray table was manufactured and installed, “no name was on it” and no marketing or promotional materials exists. (Vozick Dep. p. 35.) Finally, Mr. Vozick confirms that Applicant has made no significant monetary investment in the sale, advertising or promotions of products under the ROLL-X mark. (Vozick Dep. p.37.)

2. Declaration of Peter Nicholson

Opposer relies on the testimony by Declaration of Peter Nicholson, Vice President and Director of Communications of Rolex Watch U.S.A., Inc. (“Rolex”) primarily to support its claim that the ROLEX trademark is famous.

Rolex is the exclusive distributor and warrantor in the United States of Rolex watches, all of which bear the ROLEX trademark. (Nicholson Dec. ¶ 4.) Rolex is responsible for assembling, finishing, marketing, selling and servicing Rolex watches in the United States. Rolex maintains control over the quality of the Rolex watches it sells. Id.

The ROLEX trademark has been continuously used and registered for nearly 100 years. (Nicholson Dec. ¶ 6.) The ROLEX trademark is a coined and fanciful term with no significance or meaning other than as a trademark for high quality timepieces. (Nicholson Dec. ¶ 7.) Rolex distributes and sells its ROLEX watches through Official Rolex Jewelers. There are presently 730 Official Rolex Jewelers throughout the United States. (Nicholson Dec. ¶ 5.)

As Director of Communications, Mr. Nicholson oversees the placement of Rolex’s advertising and promotional materials. He is also knowledgeable of Rolex’s advertising expenditures as well as annual sales figures in dollars and units for Rolex watches. (Nicholson Dec. ¶ 3)

Rolex advertises in at least 46 nationally and regionally distributed publications. (Nicholson Dec. ¶ 8) A sampling of those publications are: VANITY FAIR, GOLF DIGEST, NATIONAL GEOGRAPHIC, and the WALL STREET JOURNAL. (Id., Exh. 2.) In all of its advertisements, the ROLEX trademark is prominently displayed. (Nicholson Dec. ¶ 9, Exh.3)

In Mr. Nicholson's Declaration there is a chart showing eight different years from 1984 through 2009, which are representative of and consistent with Rolex's annual advertising expenditures. (Nicholson Dec. ¶ 10.) In 1984, over 25 years ago, Rolex's advertising expenditures were nearly 10 million dollars (\$10,000.00). Since that time, Rolex's advertising budget significantly increased each year so that in 2008, Rolex's advertising expenditures were over 66 million dollars (\$66,000.00). Id.

Included in Rolex's yearly advertising budget are promotional events which Rolex sponsors. Instances of Rolex sponsored events are: nationally televised sporting events including The Masters and U.S. Open (golf events), Rolex Kentucky 3 Day (equestrian), Rolex 24 Hours at Daytona (car racing) and the Sony Ericson Open (tennis); events in the arts: including the L.A. Philharmonic, and the National Opera; and, philanthropic organizations like the Lennox Hill Neighborhood House and the Center Transitions for Dancers. (Nicholson Dec. ¶ 12.)

Mr. Nicholson's Declaration also includes a chart identifying the unit and dollar amount of sales of Rolex watches (over the same years identified in the chart of advertising expenses) beginning with 1984. In 1984, 70,638 units of Rolex watches were sold for over 120 million dollars (\$120,000,000.00). Over twenty years later, in 2006, sales reached 150,553 units for over 739 million dollars (\$739,000,000.00). (Nicholson Dec. ¶ 11.)

In further support of the recognition and fame of the ROLEX trademark, Mr. Nicholson identifies some of the countless articles mentioning the trademark and brand name ROLEX. In addition, BusinessWeek Magazine, in 2001, began publishing an annual article entitled "Best Global Brands" which lists the top 100 brands in the world. Since its inception, Rolex has always appeared on that list and in 2009 was ranked 68th most valuable brand throughout the world. (Nicholson Dec. ¶ 13.)

Mr. Nicholson also identifies several other publications like Time Magazine, Forbes and the New York Times, where the ROLEX trademark is linked with quality, status and success. Statements from such articles are: “[f]rom the red carpet to the wrists of rap stars, Rolex is recognized as the ultimate symbol of luxury,” (Time, Spring 2007); “nothing says you’ve made it like a Rolex” (Forbes, 10/8/07); and, “Rolex is the main noun in the international language of success”. (New York Times, 10/18/98). (Nicholson Dec. ¶ 13, Exh. 4.)

It is extremely important to Rolex that consumers continue to recognize and associate the ROLEX trademark exclusively with high quality, luxury timepieces. (Nicholson Dec. ¶4.)

3. Declaration of Philip Johnson

Opposer also submitted the Declaration of Philip Johnson, CEO of Leo J. Shapiro and Associates, Inc., a market research and consulting firm that conducts surveys. Mr. Johnson has 39 years of experience and has designed and supervised hundreds of surveys measuring consumer behavior, opinion and beliefs. (Johnson Dec. ¶ 1.)

In November of 2009, Mr. Johnson was retained by Rolex to design and conduct a consumer survey that would explore the extent, if any, to which purchasers of x-ray tables would think of the ROLEX trademark and/or its products when encountering an x-ray table called “ROLL-X” (Johnson Dec. ¶¶ 3&4).

Mr. Johnson identified the proper universe for the survey as potential buyers of Applicant’s goods. (Johnson Dec. ¶ 11.) In this case, a qualified survey respondent was an “animal health care professional who worked at a veterinarian office or clinic and is responsible for making the decision about purchasing an x-ray table.” (Johnson Dec. ¶¶ 5 &12, See also, Vozick Dep. pp. 19-21).

Mr. Johnson designed the study to assess the likelihood of dilution. A total of 301 telephone interviews were conducted during November 19, 2009 through February 5, 2010. (Johnson Dec. ¶ 5.) The survey employed both a test cell (200 cases) and a control cell (101 cases). The test cell exhibit bears the name ROLL-X while the control cell exhibit bears the name DIGI-X (hereafter either one is referred to as “the exhibit”). (Johnson Dec. ¶ 6 & 7.)

After being screened, each qualified respondent was asked to log onto the Internet to view the exhibit. Once on the proper site and able to view the exhibit, the qualified respondent was then asked:

Question 2a:

“Assume for a moment that you were looking for a new x-ray table and you encountered one that uses this name. Based on what you see here would you OR would you not have a belief as to who or what company puts out or sponsors this x-ray table?”

Question 2b:

“IF RESPONDENT SAYS ‘YES I WOULD,’ IN PRIOR QUESTION, ASK: Who or what company is that? IF SAYS THE NAME OF A BRAND OR COMPANY: “Can you please spell that company name for me?”

Question 2c:

*“What makes you say that? **PROBE:** What else?”*
(Johnson Dec. pp. 7,8.)

Then, respondents were asked to close their web browser for the remainder of the interview. Once closed, the interview continued, as follows:

Question 3a:

*“What, if anything, came to your mind when I first showed you the name of this x-ray table? **IF SAYS THE NAME OF A BRAND OR COMPANY:** Can you please spell that for me? **PROBE:** Anything else?”*

Question 3b:

“FOR EACH RESPONSE GIVEN IN Q.3a, ASK: What makes you say that (INSERT RESPONSE GIVEN IN Q.3a) came to your mind? **PROBE: What else?”**

Question 3c:

“FOR EACH RESPONSE GIVEN IN Q.3a, ASK: What kind of company or product is (INSERT RESPONSE GIVEN IN Q.3a)? How would you describe it to someone else if you were explaining who or what it is?

Question 4a:

“Did any other product or products come to your mind when I first showed you the name of this x-ray table?”

Question 4b:

“IF SAYS ‘YES’ IN Q.4a, ASK: What product or products is that? **IF SAYS THE NAME OF A BRAND OR A COMPANY:** Can you please spell that for me? **PROBE:** Any others?

Question 4c:

“FOR EACH RESPONSE GIVEN IN Q.4b, ASK: What makes you say that (INSERT RESPONSE GIVEN IN Q.4b) came to your mind? **PROBE:** What else?

(Johnson Dec. pp. 8,9)

The results of survey questions 2 and 3 conclude that 42% of the 200 people surveyed reported that Rolex watches came to mind when they encountered the ROLL-X name for x-ray tables.(Johnson Dec. ¶¶ 24-28 & 32.) After probing a little further and asking Question 4 to those who did not initially answer that Rolex watches came to mind, another 10% of the people surveyed responded that Rolex watches came to mind.(Johnson Dec. ¶¶ 29-32.) Based on these results it is clear that the use of the ROLL-X name in connection with x-ray tables causes a majority (52%) of those animal health care professionals who encounter it to think of Opposer’s ROLEX trademark and its watches sold under that mark. (Johnson Dec. ¶ 33)

Mr. Johnson concluded that it was his “opinion that there is a high degree of false association between x-ray tables called ROLL-X and the Rolex watch company such that a significant likelihood of trademark dilution occurs.” (Johnson Dec. ¶ 34.)

B. Applicant’s Notice of Reliance

Applicant has submitted a Notice of Reliance introducing a valid and subsisting trademark registration number 2,000,578 for DENT-X, issued September 17, 1996 for film processors for developing x-ray and photographic films and parts therefore and X-ray machines, namely X-ray sources and controls.

In its Notice of Reliance, Applicant also relies on excerpted portions of Opposer's discovery deposition transcript of David Vozick. Opposer objects to these submissions because Applicant did not file the requisite written statement explaining why it needs to rely upon the additional excerpted portions of the Vozick discovery deposition. Pursuant to 37 C.F.R. § 2.120(j)(4), if only part of a discovery deposition is relied upon the adverse party may introduce any other part of the deposition, but only to "make not misleading what was offered by the submitting party." In this case, Applicant merely provides a brief statement of relevance as to its designated transcript portions, rather than clarify why the portions of the Vozick deposition relied on by Opposer are somehow potentially misleading. While Applicant's Notice states that the additional portions should "in fairness be considered" he does not make the required "statement explaining why [Applicant] needs to rely upon each additional part listed." 37 CFR § 2.120(j)(4). Without such statement, the Board should refuse to consider these additional parts. Id.

Below, in italics, are the portions of the Vozick deposition transcript which Applicant seeks to rely upon:

"Page 10, line 14 – page 11, line 2, are relevant to show that Applicant's products are sold to veterinarian offices, animal hospitals, emergency clinics, private practices and veterinary school". (Applicant's First Notice Of Reliance, p.2)

Applicant should not be allowed to rely on this excerpt because it does not rebut or clarify Opposer's statement that x-ray tables sold by Applicant are primarily for veterinary use.

Page 15, line 23-page 17, line 3, are relevant to show that Applicant promotes and advertises its other imaging products and has used the mark DENT-X for its human dental business. Id.

This statement is irrelevant and independent of any items put forth by Opposer. It merely supports Applicant's ownership of a different registration, not relevant to this proceeding. For this reason, this excerpt should not be considered.

Page 26, line 5-page 27, line 5, are relevant to show that Applicant previously used the ROLL-X mark for a portable rolling x-ray table. Id.

Again this statement in no way relates, rebuts or clarifies any statement put forth by Opposer. While Vozick testified that he had previously used this mark, in some prior business which ceased over thirty(30) years ago, no other testimony or proof of use was elicited regarding Vozick's alleged use. This excerpt should also not be considered.

Page 32, lines 7-15, are relevant to show that Applicant suspended its promotional activities in connection with the ROLL-X mark once the opposition to the application for the mark was filed. Id.

This statement does not clarify or rebut any statement offered by Opposer. The portions of the Vozick deposition relied on by Opposer shows that no documentary evidence exists to prove Applicant's bona fide intent to use the mark at the time it filed its application. This portion sought to be relied on by Applicant relates to acts, or lack of acts, taken after the opposition was filed and should therefore not be considered.

Under these circumstances, the Board should refuse to consider Applicant's attempt to rely on portions of the Vozick deposition because Applicant has not explained why Opposer's reliance on the Vozick deposition excerpts are somehow misleading if these additional excerpts are not considered. See, 37 C.F.R. 2.120(j)(4).

III. ISSUES

A. Whether the distinctiveness of the ROLEX trademark is likely to be diluted by Applicant's use of a substantially similar mark; ROLL-X.

B. Whether Applicant possessed the requisite bona fide intent to use its ROLL-X mark at the time it filed its application.

IV. ARGUMENT

A. Dilution of the ROLEX Trademark is Likely.

Opposer's ROLEX trademark has been in use for nearly 100 years and made famous well before Applicant's proposed use of the mark, ROLL-X. (Nicholson Dec.¶ 6) As such Applicant's use of a mark which so resembles the ROLEX trademark is likely to dilute the distinctiveness of Opposer's trademark.

Opposer seeks relief under the Trademark Dilution Revision Act of 2006 (TDRA) which provides that:

the owner of a famous mark that is distinctive....shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a markthat is likely to cause dilution by blurring
15 USC § 1125 (c)

Dilution by blurring occurs when "a mark previously associated with one product also becomes associated with a second." *Visa Int'l Service Assoc. v. JSL Corp.*, 610 F. 3d 1088, 1090 (9th Cir. 2010). "For example, Tylenol snowboards, Netscape sex shops and Harry Potter dry cleaners would all weaken the commercial impression of these marks and diminish their ability to evoke their original associations." *Visa Int'l* 610 F.3d at 1090 *quoting Mattel, Inc. v. MCA Records, Inc.*, 296 F. 3d 894, 903 (9th Cir. 2002). "Even if no one suspects that the maker of

analgesics has entered into the snowboard business, the Tylenol mark will now bring to mind two products, not one.” *Id.*

This is exactly what Opposer is seeking to prevent. The ROLEX trademark has long been associated with high quality, luxury watches. To now allow a nearly identical mark, ROLL-X, to be associated with x-ray tables would weaken the commercial impression of ROLEX and allow consumers to form new and different associations which bring to mind two products, not one. *See, Id.*

In deciding this case, the Board must consider “(1) whether the Opposer’s mark is famous; (2) whether Applicant began using (or filed its application to use) its mark after Opposer’s mark became famous; and (3) whether the Applicant’s mark is likely to dilute the famous mark.” *Visa Intl. quoting Jada Toys, Inc. v. Mattel, Inc. 518 F. 3d 628, 634 (9th Cir. 2008).*

1. The ROLEX trademark is famous and has been long before Applicant filed its application.

To determine whether a mark is famous, the statute provides the following non-exclusive factors:

- (i) The duration, extent and geographic reach of advertising and publicity on the mark, whether advertised or publicized by the owner or third parties.
 - (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark
 - (iii) The extent of actual recognition of the mark.
 - (iv) Whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.
- 15 USC § 1125(c)(2)(A).

The uncontested testimony of Peter Nicholson proves that the ROLEX trademark is famous. The ROLEX trademark has been in use for almost 100 years.(Nicholson Dec.¶ 6.) Over 700 Official Rolex Jewelers sell and advertise Rolex watches throughout the United

States.(Nicholson Dec.¶ 5.) Expenses and sales figures in the United States show that Rolex has spent hundreds of millions of dollars promoting its mark and sold billions of dollars worth of watches bearing the ROLEX trademark over the past 25 years.(Nicholson Dec.¶¶ 10 &11.) These facts are certainly enough to support Rolex's claim that its ROLEX trademark is famous and has been long prior to Applicant's filing of its ROLL-X application. (See, for example, Mattel's HOT WHEELS mark was deemed famous based upon 37 years use, 350 million dollars in advertising expenditures, and three billion units sold throughout the U.S. *Jada Toys*, 518 F.3d at 636.; and also *Visa Int'l* 590 F. Supp. 2d 1306, 1315 (D of Nev. 2008) finding the VISA mark famous after 25 years of use and over \$1 billion spent in US advertising.)

Just as significant, is that for the past nine (9) years Rolex has been listed in BusinessWeek's annual article "Best Global Brands." (Nicholson Dec. ¶ 13.) BusinessWeek's list of top 100 brands has become the A-list of brand recognition. See, Alexandra J. Roberts, *"New-School Trademark Dilution: Famous Among the Juvenile Consuming Public,"* INTA, The Trademark Reporter, Vol. 100, No. 4, p1025 (7-8/2010) (stating that dilution protection under the TDRA's new definition of fame is limited to "A-List Brands" e.g. those listed in BusinessWeek's 100 Top Brands.)

As further proof of third party recognition, the ROLEX trademark and watches sold under that mark have been mentioned in countless unsolicited newspaper and magazine articles. Many of these articles associate Rolex watches with quality, status and success. (Nicholson Dec. ¶ 13)

Finally, Applicant has not submitted any evidence to refute Opposer's claim that the ROLEX trademark is famous.

Based on all of the above, Opposer's mark is clearly famous and has been long prior to Applicant's filing of its application.

2. Applicant's ROLL-X mark is likely to cause dilution.

Next, the Board must consider whether Applicant's ROLL-X mark will likely cause dilution. The TDRA has set forth six factors to consider:

- (i) The degree of similarity between the mark or trade name and the famous mark.
- (ii) The degree of inherent or acquired distinctiveness of the famous mark.
- (iii) The extent to which the owner of the famous mark is engaging in substantially exclusive use of the mark.
- (iv) The degree of recognition of the famous mark.
- (v) Whether the user of the mark or trade name intended to create an association with the famous mark.
- (vi) Any actual association between the mark or trade name and the famous mark.

15 USC § 1125(c)(2)(B).

(i) degree of similarity

The marks here are essentially identical. Where Opposer's mark has one L, Applicant's has two L's and a hyphen instead of an "e." Furthermore, there is no distinction when the marks are spoken. See, *Nike, Inc. v. Nikepal International, Inc.* 84 USPQ 2d 1820, 1827 (ED Cal. 2007) NIKE and NIKEPAL deemed nearly identical; *Visa Int'l.* 610 F.3d at 1090, finding EVISA sufficiently similar to VISA; *Jada Toys, Inc.* 518 F.3d at 634, HOT WHEELS and HOT RIGZ found to be nearly identical.

Indeed, Mr. Johnson's dilution survey shows that more than 50% of the survey respondents associate Applicant's ROLL-X mark with ROLEX. This certainly indicates that a sizable portion of Applicant's target population see the two marks as highly similar. (See Johnson Dec. ¶¶ 29-33) (See also, *National Pork Board v. Supreme Lobster and Seafood*, TTAB Opp. No.: 91166701(June 2010), p. 54, wherein the mark "THE OTHER RED MEAT" was

sufficiently similar to “THE OTHER WHITE MEAT” based on results of a dilution survey showing 35% of respondents associate Applicant’s slogan with Opposer’s.)

Based on the above, this first factor, the degree of similarity, weighs heavily in favor of a finding of likely dilution.

(ii) degree of inherent distinctiveness

“The stronger a mark the greater the protection that it is accorded by the trademark laws.” *Brookfield v. West Coast Ent. Corp.*, 174 F.3d 1036, 1058(9th Cir. 1999). “[S]uggestive, arbitrary and fanciful marks are deemed inherently distinctive and are automatically entitled to [trademark] protection because they naturally serve to identify a particular source of a product.” *Nike, Inc.* 84 USPQ 2d at 1827.

The ROLEX trademark has no meaning or significance other than as a source of high quality, luxury timepieces. (Nicholson Dec. ¶ 7.) . In *Rolex v. Canner*, decided 25 years ago, the District Court concluded that

ROLEX is properly classified as an ‘arbitrary’ or ‘fanciful’ trademark which is considered strong and is given ‘protection over a wide range of related products and variations in appearance of the mark.’ [citation omitted] Since the Rolex trademarks are strong, they are thus entitled to a high level of protection.

Rolex Watch USA v. Canner, 645 F. Supp. 484, 488 (SD Fla. 1986).

There can be little doubt that ROLEX is a strong, inherently distinctive mark. Accordingly, this factor also heavily favors a finding of likelihood of dilution.

(iii) substantially exclusive use

“The law does not require that use of the famous mark be absolutely exclusive, but merely ‘substantially exclusive.’” *Nike, Inc.*, 84 USPQ 2d at 1827. Applicant has not offered any evidence of third party use. Therefore, nothing in the record before the Board indicates that

there is any legitimate third party use of the ROLEX trademark. As such, this factor also weighs in favor of likely dilution.

(iv) degree of recognition

The fourth factor, the degree of recognition of the ROLEX trademark, also weighs heavily in favor of Opposer. As previously stated, over the past 25 years, millions of Rolex watches have been sold and billions of dollars spent in national advertising and promotion of Rolex watches. (Nicholson Dec. ¶¶ 10&11.) See, *PerfumeBay.com Inc. v. eBay.com Inc.*, 506 F.3d 1165, 1181 (9th Cir. 2007) (finding that eBay is a widely known mark and has attained this status as a result of expending considerable resources.)

Similarly, there have been countless unsolicited newspaper and magazine articles that mention the ROLEX trademark and the watches sold under that mark. (Nicholson Dec. ¶ 13)

In addition, for the past nine years Rolex has been listed and valued as one of the top 100 brands in the world. (Nicholson Dec. ¶ 13) As such, it would be difficult to find a consumer who does not recognize the ROLEX trademark.

(v) intent

As to the fifth factor, the record is vacant as to whether Applicant intended to create an association with Rolex. However, given the broad recognition and the public's association of the ROLEX trademark with a high standard of quality, workmanship and status, it is doubtful that Applicant did not consider these attributes when naming its product.

(vi) actual association between ROLL-X and ROLEX

Since Applicant has filed an intent to use application and has to date not actually used the mark ROLL-X, it is impossible to present any evidence of actual association. However, Opposer's survey evidence shows that over 50% of respondents associate Applicant's ROLL-X

mark with Opposer's ROLEX mark.² This clearly demonstrates there is a strong association between the marks. (Johnson Dec. ¶ 33) See, *Jada Toys*, 518 F3d at 636 (survey finding that 28% of respondents thought toy vehicle put out under HOT RIGZ name was either made by Mattel or produced by same company that put out HOT WHEELS, was sufficient to establish existence of likely dilution.)

In Mr. Johnson's undisputed expert opinion, "there is a high degree of false association between x-ray tables called ROLL-X and the Rolex watch company." (Johnson Dec. ¶ 34.)

Each factor, prescribed by the dilution statute, favors Opposer and therefore requires a finding of a likelihood of dilution.

B. Applicant Lacked a Bona Fide Intent to Use the Mark ROLL-X at the Time the Trademark Application was Filed.

Trademark Act Section 1(b), 15 USC § 1051(b), states that "a person who has a bona fide intention, under circumstances showing good faith, to use a trademark in commerce" may apply for registration of the mark. A determination of "... whether an applicant has a bona fide intention to use the mark in commerce is to be a fair, objective determination based on all the circumstances." *The Saul Zaentz Co. v. Bumb*, 95 USPQ2d 1723(TTAB June 2010). Evidence of bona fide intent

is 'objective' in the sense that it is evidence in the form of real life facts and by the actions of the applicant, not by the applicant's testimony as to its subjective state of mind. That is, Congress did not intend the issue to be resolved simply by an officer of applicant later testifying, "Yes, indeed, at the time we filed that application, I did truly intend to use the mark at some time in the future."

² In this case, the universe of respondents was limited to potential consumers of Applicant's goods, i.e., animal health care professionals. This is a narrower more limited universe than the universe of Opposer's goods which would be the general public.

J.T. McCarthy, McCarthy on Trademarks and Unfair Competition,

§19:14 (4th ed. 2009)

The TTAB has consistently ruled that the absence of any documentary evidence on the part of an applicant constitutes objective proof sufficient to demonstrate that applicant lacked a bona fide intent to use its mark at the time it filed the application. See, *Honda Motor Co. v. Winkelman*, 90 USPQ 2d 1660, 1664 (2009)(even though Applicant used the mark outside the US, the Board found Applicant offered no documentary or objective evidence to support its intent to use in the U.S.); *The Saul Zaentz Co.*, 95 USPQ2d 1723 (“lack of documentary evidence suffices to establish opposer’s prima facie case that applicant lacked the requisite bona fide intent to use the mark in commerce as of the application filing date”); *Commodore Electronics Ltd. V. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1507(TTAB 1993).

In the present case, Applicant has not offered any documentary evidence to support its claim that it had a bona fide intent to use the mark at the time it filed its application.(Vozick Dep. pp.34-37) Applicant merely states that it put its plans on hold, after Opposer filed this Opposition.(Vozick Dep. p.32) However, it is the date the application is filed which is critical to the bona fide intent to use issue and Applicant’s reasons for its inaction once the Opposition is filed is irrelevant. It is obvious from the lack of documentary evidence that Applicant was merely trying to reserve a right in the mark but took no actual steps to prepare for using the mark at the time the application was filed. This is insufficient to objectively demonstrate that Applicant had a bona fide intent to use the mark. See, *The Saul Zaentz Co.*, 95 USPQ2d 1723 (applicant’s statements, during his deposition, showed his intention was merely to reserve a right in the term without specific intent to use the mark.)

In *Research in Motion, Ltd. v. NBOR Corp. (2007)*, the TTAB found that applicant lacked the requisite bona fide intent and specifically referred to applicant's discovery responses:

[1] it has not offered any goods or services for sale under the involved mark; [2] the mark has not been used and no plans have been made as to how the mark may be used; [3] there is no projected date of first use in commerce; [4] no channels of trade have been formulated or planned for the future; [5] the classes of consumers and geographic areas of sale have not yet been determined; [6] applicant has not undertaken any market studies, surveys, or focus groups; and [7] no documents exist regarding plans for expansion and growth of the product and service lines under the mark.

Research In Motion, Limited v. NBOR Corporation, Opposition No. 91179284, at pp 11, 12 (TTAB 12/2009).

In that case, the only proof submitted by applicant was earlier applications for the same or a similar mark and correspondence with its attorney (which were identified but not produced due to attorney-client privilege). The Board ruled that this was not sufficient to demonstrate applicant had the requisite intent. *Id.*

Here, similar to the applicant in *Research in Motion*, Applicant has not offered goods for sale under the mark; the mark has not been used and no plans have been made as to how the mark may be used; there is no projected first use date; no market studies or surveys have been conducted; and no documents exist regarding plans for the mark. (Vozick Dep. pp 34-37). While Applicant testified that the channels of trade and classes of consumers would basically be his existing clientele, Applicant has made no investment, of time or money, into the use of the ROLL-X mark. (Vozick Dep. p. 37).

The conclusion, in this instance, should be similar to that in *Research in Motion* (and other cases cited herein) Applicant's lack of documentary evidence proves that it lacked the

requisite intent to use the mark ROLL-X at the time it filed its application. Applicant's mark should therefore be refused registration.

V. CONCLUSION

In this case, Applicant has chosen to seek registration of a mark that sounds and looks nearly identical to Opposer's world famous, incontestable trademark; ROLEX. That the goods are not related is irrelevant. Opposer's survey clearly shows that use of a ROLL-X mark in connection with x-ray tables causes a high degree of false association with the ROLEX trademark and watches sold under that mark such that dilution of the ROLEX trademark is likely.

A mark as famous as ROLEX, should remain a single source identifier for high quality, luxury timepieces. To allow Applicant to use the mark ROLL-X will whittle away at the distinctiveness of the ROLEX trademark and potentially weaken the commercial impression that Opposer has created through 100 years of nearly exclusive use, millions of dollars in advertising and billions of dollars in sales.

Applicant's mark should also be refused registration on the grounds that it lacked the requisite bona fide intent to use the mark at the time the application was filed. Applicant's failure to provide any documentary evidence is sufficient to support Opposer's claim that Applicant had no bona fide intent to use the mark at the time it filed the application. Applicant's excuse for its inaction after the Opposition was filed is irrelevant because it is the date the application was filed that is critical to the bona fide intent issue. The lack of documentary evidence clearly proves that Applicant took no actual steps to prepare for using the mark at the time the application was filed.

For all of the foregoing reasons, the evidentiary record in this case, supports findings by the Board that Rolex's Opposition should be sustained on the ground of likelihood of dilution and on the separate ground that Applicant at the time it filed the application did not have a bona fide intent to use the mark on the goods or in connection with the goods.

Respectfully submitted,

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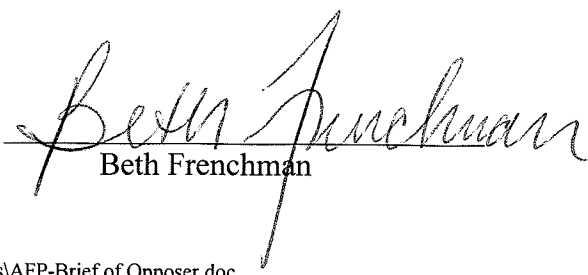
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing BRIEF OF OPPOSER has been served on Applicant this 9th day of February, 2011 via first class mail, postage prepaid to:

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